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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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John Francis Chiarello

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10/10/2003

KEIL & WEINKAUF  
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WASHINGTON, DC 20036

EXAMINER

PRATS, FRANCISCO CHANDLER

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 10/10/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/921,188

Applicant(s)

CHIARELLO ET AL.

Examiner

Francisco C Prats

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

Claims 1-11 are pending and are examined on the merits.

#### *Claim Rejections - 35 USC § 102/103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claim 10 is rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Dickel et al (U.S. Pat. 3,880,916) or Elliot et al (U.S. Pat. 4,137,324).

Both patents describe products which are identical to those recited in claim 10, when moiety Q is  $-\text{CO}_2\text{H}$ , or  $-\text{CO}_2\text{CH}_3$ . See Dickel at column 3, line 62, through column 4, line 16, stating in relevant part:

Preferred compounds of the invention are those of Formula II . . . **or the lower alkyl esters thereof.**

***Epecially valuable*** are compounds of the formula II in which  $\text{R}_5$  is cyclopropyl . . . ,  $\text{R}_6$  is hydrogen . . . and  $\text{R}_7$  is . . . chlorine. (Emphasis added.)

A comparison of applicant's formula in claim 10 to Formula II of Dickel, combined with the moieties described by Dickel as being "preferred" or "especially valuable", make it clear that when moiety Q is  $-\text{CO}_2\text{H}$ , or  $-\text{CO}_2\text{CH}_3$ , Dickel describes the compounds recited in claim 10.

Similarly, Elliot describes that his insecticidal esters are prepared from carboxylic acids containing both the chlorophenyl and cyclopropyl moieties recited in the formula in claim 10. See column 4, lines 3-35, including formula II. See also column 2, lines 44-48, wherein hydrogen is the "preferred" moiety at  $\text{R}_1$ , and chlorine in the para position (i.e., the same

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position as applicant's claim 10) as being among the three preferred moieties at position  $R_6$ . Thus, because the carboxylic acids used by Elliot to prepare his insecticidal esters have the same substituents at the same positions as recited in claim 10, Elliot clearly describes the compounds recited in claim 10 when moiety Q is  $-\text{CO}_2\text{H}$ . Moreover, Elliot clearly describes that one method of preparing his insecticidal esters is by transesterification using "a lower alkyl ester of the aryl acetic acid, where the alkyl group contains 1-3 carbon atoms . . ." See column 4, lines 30-35. Thus, Elliot also describes compounds recited in claim 10, when moiety Q is  $-\text{CO}_2\text{CH}_3$ .

In sum, a comparison of applicant's formula in claim 10 to Formula II of Elliot, combined with the moieties described by Elliot as being "preferred", make it clear that when moiety Q is  $-\text{CO}_2\text{H}$ , or  $-\text{CO}_2\text{CH}_3$ , Elliot describes the compounds recited in claim 10. Thus, directly contrary to applicant's assertions in the petition of the restriction requirement, and directly contrary to the assertions in the decision on said petition, both Elliot and Dickel disclosed compounds encompassed by claim 10. A holding of anticipation is required.

Despite the apparent direct description of the compounds recited in claim 10 when moiety Q is  $-\text{CO}_2\text{H}$ , or  $-\text{CO}_2\text{CH}_3$ , one of ordinary skill might not clearly envisage the compounds recited

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in claim 10 when moiety Q is  $-\text{CO}_2\text{H}$ , or  $-\text{CO}_2\text{CH}_3$ . However, based on the discussion above, both references clearly suggest the preparation of the claimed compounds. Compounds having all of the claimed moieties are indicated as being either "especially valuable" or "preferred." Thus, the artisan of ordinary skill viewing either reference would clearly have been motivated to have prepared the claimed compounds. Therefore, even if the disclosure of the references is considered legally insufficient for a holding of anticipation, a holding of obviousness is clearly required based on the disclosures of the references. Lastly, note that the two references are being applied separately, not in combination.

Claims 1-9 are allowed. Claim 10 would be allowable if amended to delete the recitation "  $-\text{CO}_2\text{H}$ ;  $-\text{CO}_2\text{CH}_3$  ". Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francisco C Prats whose telephone number is 703-308-3665. The examiner

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can normally be reached on Monday through Friday, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Wityshyn can be reached on 703-308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Francisco C Prats  
Primary Examiner  
Art Unit 1651

FCP